

II. REMARKS

Claim Rejections Pursuant to 35 U.S.C. 102(b)

35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

MPEP §2131 recites:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner rejects claims 1-4, 6-15, 17-24, 26-32 and 35-40 pursuant to 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,831,526 to Luchs et al.

Claim 1 Rejections

The Examiner rejects claim 1. The response is given accordingly.

The Examiner asserts that the claimed method of "processing an insurance application" and "receiving the application for insurance from a user over a computer network" is anticipated by Luchs, and a teaching therein of a terminal having an input, such

as a keyboard, and a display, which communicate the data in the Central Processor. In support of this, the Office Action cites column 3, lines 5-16 of Luchs.

1. The Applicants respectfully disagree with this conclusion. Luchs at column 3, lines 5-16 refers to the use of a plurality of terminals having input and display devices. The OFFICE ACTION fails to address that the plurality of steps recited in claim 1 are all executed in a single user session. Luchs does not teach that the processing of an insurance application, including the step of receiving an application for a policy of insurance from a user over a computer network, occurs during a single user session.

2. The Office Action asserts that the claim step of "automatically approving or denying of the application based on comparison of data contained in the application with stored underwriting criteria" is anticipated by the electronic input function of Luchs, which scans inputted information and stored data to help determine whether the criteria for approving or disapproving an application are satisfied (see Luchs at column 7, lines 29-31 and column 8, lines 1-8).

The Applicants respectfully disagree with this conclusion. The electronic input function of Luchs scans input information and stored data for the purpose of collecting statistics for use in determining whether the criteria for sending an application to the underwriting department are realistic. Claim 1 of the instant application does not include a determining of whether an underwriting department should address an application, as this underwriting department department step would involve an additional session that would prevent the complete processing of an insurance application in a single user session, as required by claim 1 of the instant application.

3. The Office Action asserts that the claim step of "automatically offering of a policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance" is anticipated by Luchs in the decision step (step 120 in Luchs), in which a client is offered a policy and must choose to accept or decline (see Luchs at column 17, lines 1-15).

The Applicants respectfully disagree with this conclusion. The referenced step of Luchs refers to the underwriters decision as to whether the underwriter can authorize the applied for policy, or whether the policy must be approved at a higher underwriter level. Claim 1 of the instant application is not directed to such an underwriting decision. The addition of an underwriter and an underwriter decision into the method of claim 1 would violate the claim element that the transaction be conducted in a single user session.

4. The Examiner asserts that the claim step of "issuing the policy upon electronic acceptance of the user when all steps are completed during a single user session" is anticipated by Luchs in the step wherein the client and underwriter reaching approval of the policy, and the policy being prepared for printing and mailing once all previous steps are completed (see Luchs at column 17, lines 31-40).

The Applicants respectfully disagree with this conclusion. As stated above, the addition of a human underwriter approval session, beyond the session of the single user, would necessitate an additional step that would violate the claim 1 requirement that the transaction be conducted in a single user session.

Luchs does not teach the invention claimed in claim 1 of the instant application. Therefore, the 35 U.S.C. 102(b) rejection to claim 1 is traversed.

Claim 2 Rejection

The Examiner rejects the dependant claim 2. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claim 2 is dependent on claim 1. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 1 above, the dependent claim 2 is allowable because of its dependence on the allowable independent claim 1. Therefore, the 35 U.S.C. 102(b) rejection to claim 2 is traversed.

Claim 3 Rejection

The Examiner rejects the dependant claim 3. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claim 3 is dependent on claim 1. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 1 above, the dependent claim 3 is allowable because of its dependence on the allowable independent claim 1. Therefore, the 35 U.S.C. 102(b) rejection to claim 3 is traversed.

Claim 4 Rejection

The Examiner rejects the dependant claim 4. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claim 4 is dependent on claim 1. A dependant claim serves to further narrow an independent claim and as such is

allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 1 above, the dependent claim 4 is allowable because of its dependence on the allowable independent claim 1. Therefore, the 35 U.S.C. 102(b) rejection to claim 4 is traversed.

Claims 6-12 Rejection

The Examiner rejects the dependant claims 6-12. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claims 6-12 are dependent on claim 1. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 1 above, dependent claims 6-12 are allowable because of their dependence on the allowable independent claim 1. Therefore, the 35 U.S.C. 102(b) rejection to claims 6-12 is traversed.

Claim 13 Rejections

The Examiner rejects claim 13. The response is given accordingly:

The Examiner asserts that the claim method of "processing an application for an amendment to an existing policy or insurance" and "receiving the application for an amendment to a policy of insurance from a user over a computer network" is anticipated by Luchs and a teaching therein of a terminal having an input, such as a keyboard, and a display, which communicate the data in the central processor which then checks for error to be corrected (See Luchs at Column 16, lines 31-67).

The Applicants respectfully disagree with this conclusion. Luchs at column 16, lines 31-67 discusses the step of underwriting review, the underwriting evaluation, a description of the underwriters 'in box,' and a discussion of the levels of human underwriting authority needed to process an application for an insurance policy. No reference is made in the cited passage to receiving an application over a computer network. Further, claim 13 of the instant application is drawn to a method of processing an application for an amendment to an existing policy, and includes certain steps subject to the remarks made hereinabove with respect to independent claim 1, including the requirement that the steps of claim 13 be performed in a single user session. Thus, the remarks made hereinabove with respect to the steps of "automatically approving or denying of the application based on comparison of data contained in the application with stored underwriting criteria," "automatically offering of a policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance," and "issuing the policy upon electronic acceptance of the user when all steps are completed during a single user session" are equally applicable to claim 13.

Luchs does not teach the claim 13 invention of the instant application. Therefore, the 35 U.S.C. 102(b) rejection to claim 13 is traversed.

Claim 14 Rejections

The Examiner rejects claim 14. The response is given accordingly:

1. The Examiner asserts that the claim elements of "computerized system for processing an insurance application during a single user session" and "means for receiving the application of insurance from a user over a computer network" is anticipated by Luchs,

and a teaching therein of a terminal having an input, such as a keyboard, and a display, which communicate the data in the central processor (See Luchs at column 3, lines 5-16).

The Applicants respectfully disagree with this conclusion. Luchs at column 3, lines 5-16 refers principally to the use of a plurality of terminals having input and display devices. The OFFICE ACTION does not address that the plurality of steps recited in claim 14 of the application are all executed in a single user session. Luchs does not teach that the processing of an insurance application, including the step of receiving an application for a policy of insurance from a user over a computer network, occurs during a single user session.

2. The Examiner asserts that the claim element "means for automatically approving or denying of the application during a user session based on a comparison of data contained in the application with stored underwriting criteria" is anticipated by the electronic input function of Luchs, which scans inputted information and stored data to help determine whether the criteria for approving or disapproving an application are satisfied (see Luchs at column 7, lines 29-31 and column 8, lines 1-8).

The Applicants respectfully disagree with this conclusion. The electronic input function of Luchs scans input information and stored data for the purpose of collecting statistics that help determine whether the criteria for sending an application to the underwriting department are realistic. Claim 14 of the instant application does not include a determining of whether the underwriting department should become involved with an application, as this would involve an additional step that would prevent the complete processing of an insurance application in a single user session, as required by claim 14 of the instant application.

3. The Examiner asserts that the claim step of "automatically offering of a policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance" is anticipated by Luchs in the decision step (Referred to as step 120 in Luchs), in which a client is offered a policy and at this point must choose to accept or decline (see Luchs at column 17, lines 1-15).

The Applicants respectfully disagree with this conclusion. The referenced step of Luchs refers to the underwriters decision as to whether the underwriter can authorize the applied for policy, or whether the policy must be approved at a higher underwriter level. Claim 14 of the instant application is not directed to any such decision. The addition of an underwriter and an underwriter decision into the method of claim 14 would violate the claim element that the transaction be conducted in a single user session.

4. The Examiner asserts that the claim element of "means for issuing the policy upon electronic acceptance of the user when all steps are completed during a single user session" is anticipated by Luchs in the step of the client and underwriter reaching approval of the policy, and the policy being prepared for printing and mailing once all previous steps are completed (see Luchs at column 17, lines 31-40).

The Applicants respectfully disagree with this conclusion. Applicants note that the phrase "when all steps are completed during a single user session" is not stated in claim 14. The last element in claim 14 reads "means for issuing the policy during the user session upon electronic acceptance thereof by the user." The claim indicates that the element includes acceptance by a singular entity, *i.e.*, a user. The cited reference suggests that both

the client and the underwriter must approve the policy. That would constitute the action of two distinct entities and two entities are not included in claim 14.

Luchs does not teach the claim 14 invention of the instant application. Therefore, the 35 U.S.C. 102(b) rejection to claim 14 is traversed.

Claim 15 Rejection

The Examiner rejects the dependant claim 15. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claim 15 is dependent on claim 14. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 14 above, the dependent claim 15 is allowable because of its dependence on the allowable independent claim 14. Therefore, the 35 U.S.C. 102(b) rejection to claim 15 is traversed.

Claim 17-22 Rejection

The Examiner rejects the dependant claims 17-22. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claims 17-22 are dependent on claim 14. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 14 above, dependent claims 17-22 are allowable because of their dependence on the allowable independent claim 14. Therefore, the 35 U.S.C. 102(b) rejection to claims 17-22 is traversed.

Claim 23 Rejections

The Examiner rejects claim 23. The response is given accordingly:

1. The Examiner asserts that the claim element of "A computerized system for processing an insurance application during a single user session, comprising: a server and a database wherein said server transmits an application for a policy of insurance to a user over a computer network during a user session in response to a request therefor from the user" is anticipated by Luchs and a teaching therein of a central processor and each terminal having the means to input and retrieve information in the data bank to respond to the information entered by the terminal operator (see Luchs at column 3, lines 5-30).

The Applicants respectfully disagree with this conclusion. Luchs at column 3, lines 5-30 refers to the use of a plurality of terminals having input and display devices. Additionally, the cited reference teaches that a form for an application or quote is displayed on the operators terminal, and that the form is provided by the central processor. However, the Examiner overlooks the fact that there are many elements in claim 23 and that all of the elements must be satisfied during a single user session. Luchs does not teach that the complete processing of an insurance application is to occur during a single user session.

2. The Examiner asserts that the claim element of "the server automatically approves or denies the application during the user session based on a comparison of data contained in the application with stored underwriting criteria" is anticipated by Luchs and a teaching therein that by the electronic input function which scans inputted information and stored data to help determine whether the criteria for approving or disapproving an application are satisfied (see Luchs at column 7, lines 29-31 and column 8, lines 1-8).

The Applicants respectfully disagree with this conclusion. The electronic input function of Luchs scans input information and stored data for the purpose of collecting statistics that help determine whether the criteria for sending an application to the underwriting department are realistic. Claim 23 of the instant application does not include a determining of whether the underwriting department should see an application, as this involves an additional step that prevents the complete processing of an insurance application in a single user session, as required by Claim 23 of the instant application.

3. The Examiner asserts that the element of "the server automatically offers of a policy of insurance to the user during the user session in response to the application over the computer network if the application is approved and presents the policy during the user session to the user for electronic acceptance" is anticipated by Luchs in the decision step (Referred to as step 120 in Luchs) in which a client is offered a policy and at this point must choose to accept or decline (see Luchs at column 17, lines 1-15).

The Applicants respectfully disagree with this conclusion. The referenced step of Luchs refers to the underwriters decision as to whether the underwriter can authorize the applied for policy, or whether the policy must be approved at a higher underwriter level. Claim 23 of the instant application is not directed to any such decision. The addition of an underwriter and an underwriter decision in claim 23 would violate the claim element that the offering of the policy during the user session be conducted in a single user session.

4. The Examiner asserts that the claim element of the "the server applicant is the insured party of the policy and the insured party purchases the policy directly from the insurer" is anticipated by Luchs by the client giving approval and the issuer giving approval for printing and mailing to the client (see Luchs at column 17, lines 31-66).

The Applicants respectfully disagree with this conclusion, as the recited claim element is not an element of Claim 23.

Luchs does not teach the claim 23 invention of the instant application. Therefore, the 35 U.S.C. 102(b) rejection to claim 23 is traversed.

Claim 24 Rejection

The Examiner rejects the dependant claim 24. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claim 24 is dependent on claim 23. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 23 above, the dependent claim 24 is allowable because of its dependence on the allowable independent claim 23. Therefore, the 35 U.S.C. 102(b) rejection to claim 24 is traversed.

Claims 26-31 Rejection

The Examiner rejects the dependant claims 26-31. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claims 26-31 are dependent on claim 23. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 23 above, dependent claims 26-31 are allowable because of their dependence on the allowable independent claim 23. Therefore, the 35 U.S.C. 102(b) rejection to claims 26-31 is traversed.

Claim 32 Rejections

1. The Examiner asserts that the claimed "computer-readable medium tangibly embodying instructions which, when executed by a computer, implement a process" for "receiving an application for a policy of insurance from a user over a computer network" is anticipated by Luchs and a teaching therein of a terminal having an input, such as a keyboard, and a display which communicate the data in the central processor. (see Luchs at column 3, lines 5-16).

The Applicants respectfully disagree with this conclusion. Luchs at column 3, lines 5-16 refers to the use of a plurality of terminals having input and display devices. The OFFICE ACTION overlooks the fact that there are many steps recited in Claim 32 of the application and that all of those steps are executed in a single user session. Luchs does not teach that the processing of an insurance application occurring during a single user session.

2. The Examiner asserts that the claim method of "automatically approving or denying the application based on a comparison of data contained in the application with stored underwriting criteria" is anticipated by Luchs and a teaching therein that the electronic input function which scans inputted information and stored data to help determine whether the criteria for approving or disapproving an application are satisfied (see Luchs at column 7, lines 29-31 and column 8, lines 1-8).

The Applicants respectfully disagree with this conclusion. The electronic input function of Luchs scans input information and stored data for the purpose of collecting statistics that help determine whether the criteria for sending an application to the underwriting department are realistic. Claim 32 of the instant application does not include a determining of whether the underwriting department should see an application, as the

decision of an underwriter would not be automatic as indicated by the language of claim 32. Also, the underwriting department approval involves an additional step that prevents the complete processing of an insurance application in a single user session, as required by Claim 32 of the instant application.

3. The Examiner asserts that the element of "automatically offering of a policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance" is anticipated by Luchs in the decision step (Referred to as step 120 in Luchs) in which a client is offered a policy and at this point must choose to accept or decline (see Luchs at column 17, lines 1-15).

The Applicants respectfully disagree with this conclusion. The referenced step of Luchs refers to the underwriters decision as to whether the underwriter can authorize the applied for policy, or whether the policy must be approved at a higher underwriter level. Claim 32 of the instant application is not directed to any such decision. The addition of an underwriter and an underwriter decision in claim 32 would violate the claim element that the offering of the policy occur during a single user session.

4. The Examiner asserts that the claim element of the "applicant is the insured party of the policy and the insured party purchases the policy directly from the insurer" is anticipated by Luchs by the client giving approval and the issuer giving approval for printing and mailing to the client (see Luchs at column 17, lines 31-66).

The Applicants respectfully disagree with this conclusion. The recited claim element is not an element of Claim 32.

Luchs does not teach the claim 32 invention of the instant application. Therefore, the 35 U.S.C. 102(b) rejection to claim 32 is traversed.

Claim 33 Rejection

The Examiner rejects the dependant claim 33. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claim 33 is dependent on claim 32. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 32 above, the dependent claim 33 is allowable because of its dependence on the allowable independent claim 32. Therefore, the 35 U.S.C. 102(b) rejection to claim 33 is traversed.

Claims 35-40 Rejection

The Examiner rejects the dependant claims 35-40. The response is given accordingly:

The Applicants respectfully disagrees with the rejection. Claims 35-40 are dependent on claim 32. A dependant claim serves to further narrow an independent claim and as such is allowable if the independent claim on which it depends is allowable. Based on the reasoning traversing the rejection of claim 32 above, dependent claims 35-40 are allowable because of their dependence on the allowable independent claim 32. Therefore, the 35 U.S.C. 102(b) rejection to claims 35-40 is traversed.

Claim Rejections Pursuant to 35 U.S.C. 103

35 USC 103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

MPEP 706.02(j) recites:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner rejects claims 5, 16, 25, and 34 pursuant to 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 48315265 to Luchs et al. in view of U.S. Patent No. 6,064,987 to Walker et al. The Examiner states that Luchs et al. fails to disclose a method for receiving a credit card number from the applicant prior to issuance of the policy for use

in payment of premiums. But the Examiner also states that Walker et al. discloses the use of credit cards to pay for any desired purchase (see Walker column 1, lines 19-45). The Examiner then states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use credit cards, as was shown by Walker, in the insurance application system of Luchs, in order to facilitate the process of payment because the use of an electronic payment system would create a more efficient and effective method for the payment for the insurance policy.

The Applicants respectfully disagree. Luchs, the primary reference, does not teach the invention in the instant application. Therefore, the suggested combination of the references, even if there was a suggestion to combine does not make out the entire recitation of the invention in the instant application. Specifically, independent claims 1, 13, 14, 23, and 32 all recite the inventive element of operating the invention during "a single user session". This inventive element is not included in the primary reference, Luchs. Consequently, the addition of the installment credit payment system of Walker would still not result in the invention disclosed in the instant application. Further, there is no suggestion in Luchs or Walker to combine these references.

Additionally, the Examiner Office Action rejects dependent claims 5, 16, 25, and 34 pursuant to 35 U.S.C. 103(a). Dependent claims 5, 16, 25, and 34 depend upon independent claims 1, 14, 23, and 32 respectively, and those independent claims are allowable via the analysis presented in the Remarks on the 35 U.S.C. 102(b) rejections above. Consequently, the suggested combination of Luchs and Walker cannot render obvious the recitation of dependent claims 5, 16, 25, and 34 for purposes of 35 U.S.C. 103(a). Claims 5, 16, 25, and 34 are therefore patentable over the suggested combination of references.

Conclusion

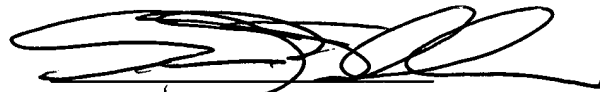
Applicants respectfully request reconsideration of the subject application in light of the reasons set forth herein. Applicants respectfully request early and favorable action on claims 1-40.

III. AMENDED CLAIMS VERSION WITH CHANGES MARKED

4. (Amended) The method of claim 1, wherein the [applicant] user is the insured party of the policy and the insured party purchases the policy directly from the issuer thereof.
15. (Amended) The system of claim 14, wherein the [applicant] user is the insured party of the policy and the insured party purchases the policy directly from the issuer thereof.
24. (Amended) The system of claim 23, wherein the [applicant] user is the insured party of the policy and the insured party purchases the policy directly from the issuer thereof.
33. (Amended) The computer-readable medium of claim 32, wherein the [applicant] user is the insured party of the policy and the insured party purchases the policy directly from the issuer thereof.

Respectfully submitted,

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